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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/748,125	12/27/2000	Matthew Rozek	088305/0132	4154
7590	05/06/2004		EXAMINER	
William T. Ellis FOLEY & LARDNER Washington Harbour 3000 K Street, N.W., Suite 500 Washington, DC 20007-5109			SCHLAIFER, JONATHAN D	
			ART UNIT	PAPER NUMBER
			2178	6
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Please find below and/or attached an Office communication concerning this application or proceeding.

RPL

## Office Action Summary

Application No.	Applicant(s)
09/748,125	ROZEK ET AL.
Examiner	Art Unit
Jonathan D. Schlaifer	2178

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM  
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

1) Responsive to communication(s) filed on 27 December 2000.  
2a) This action is FINAL.                    2b) This action is non-final.  
3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

4) Claim(s) 1-20 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) Claim(s) \_\_\_\_\_ is/are allowed.  
6) Claim(s) 1-20 is/are rejected.  
7) Claim(s) \_\_\_\_\_ is/are objected to.  
8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

9) The specification is objected to by the Examiner.  
10) The drawing(s) filed on 27 December 2000 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) All    b) Some \* c) None of:  
1. Certified copies of the priority documents have been received.  
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

1) Notice of References Cited (PTO-892)  
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 5.

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.  
5) Notice of Informal Patent Application (PTO-152)  
6) Other: \_\_\_\_\_.

## **DETAILED ACTION**

1. This action is responsive to application 09/748,125 filed on 12/27/2000, with prior art filed on 12/27/2000.
2. Claims 1-20 are pending in the case. Claims 1 and 18-20 are independent claims.

### ***Claim Objections***

3. Claims 19-20 objected to because of the following informalities: These claims are independent claims that are improperly made dependent on claim 1. The claims should be revised to explicitly contain the contents of claim 1. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claim 20 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.
5. Computer programs claimed as computer listings *per se*, i.e., the descriptions or expressions of the programs, are not physical "things." They are neither computer components nor statutory processes, as they are not "acts" being performed. Such claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed elements of a computer which permit the computer program's functionality to be realized. In contrast, a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of

the computer which permit the computer program's functionality to be realized, and is thus statutory. Accordingly, it is important to distinguish claims that define descriptive material *per se* from claims that define statutory inventions.

6. For purposes of examination, claim 20 will be read as if it referred to a computer program encoded on a computer-readable medium.

*Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. **Claims 1-2, 6-7, 11-12, 14-17, and 19-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Puckett (USPN 5,572.670—filing date 1/10/1994).**
8. **Regarding independent claim 1**, Puckett discloses a process for tracking inbound documents in a business-to-business electronic commerce system (in the Abstract, line 1, Puckett's invention is a bi-directional translator, which could serve this role in an electronic commerce system), the process comprising the steps of: a) receiving an inbound document at a translator (in col. 6, lines 15-20, there is an interpreter-converter module); b) the translator checking compliance of the document for translation from a source format to a desired target format (in col. 6, lines 20-25, the interpreter-converter checks the document as it converts it); c) attempting translation of the document, and capturing error data representing errors to a tracking database (in col. 2, lines 60-67, there is an error log database); and d) extracting data from the document and using it to provide

and internal document identifier, and saving the internal document identifier to the tracking database as an index for the error data (in col. 3, lines 4-12, the error log database saves records about the document as identifiers to index the error data).

9. **Regarding dependent claim 2**, Puckett discloses that step b) comprises attempting recognition of syntax formats within a document data stream for compliance with configured formats, and configuring the translator in col. 6, lines 55-65 (there are specific linguistic rules that govern the translation process).
10. **Regarding dependent claim 6**, Puckett discloses in steps 304 and 308 on Figure 3 that when an error is detected, it is processed and the document data stream is returned to.
11. **Regarding dependent claim 7**, Puckett discloses in steps 304 and 308 on Figure 3 that errors are detected at the stage of a mapping process in which a field of a target document is not populated because the errors are detected before the event records have been encoded as tuples.
12. **Regarding dependent claim 11**, Puckett discloses that step d) comprises extracting data from both a document's enveloping information and from within the document, see col. 3, lines 5-7, "These events can be errors in the storage system or simply routine observations about the storage system."
13. **Regarding dependent claim 12**, Puckett discloses a process wherein error data is captured by writing values to variables in memory, and subsequently saving said values to the tracking database referenced to the internal document identifiers, see Fig. 3, items 308-316, Fig. 3 details how tuples are stored in a metalanguage (which must occur in variables), and then outputted to a database.

14. **Regarding dependent claim 14**, Puckett discloses a process wherein the memory variables include a list variable which can reference a plurality of values (in Fig. 3, item 308, the converter operates on tuples which involve a plurality of values).
15. **Regarding dependent claim 15**, Puckett discloses a process wherein error data is mapped to said variables according to mapping rules (in Fig. 3, item 312, there is a translation process, which must inherently involve a mapping according to mapping rules.)
16. **Regarding dependent claim 16**, Puckett discloses a process, wherein each variable has a label (variables inherently must have labels for a program to operate on them), and referencing a label of a variable in a mapping rule declares said variable (in col. 4, lines 10, referencing tuples activates the tuple and therefore must declare it).
17. **Regarding dependent claim 17**, Puckett discloses a process wherein step c) comprises generating an error code indicating the nature of the error, there being a pre-stored set of error codes and associated descriptions (in col. 6, lines 15-42 Pucket describes the generation of the error codes and the predetermined language used to do so.)
18. **Regarding independent claim 19**, the claim is an electronic commerce system that comprises means for performing the process of claim 1, and is rejected under similar rationale.
19. **Regarding independent claim 20**, the claim is a computer program encoded on a computer-readable medium designed to perform the process of claim 1 and is rejected under similar rationale.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

20. **Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Puckett, further in view of Dysart et al. (USPN 6,708,166 B1—filing date 5/11/2000), hereinafter Dysart, further in view of Casper et al. (USPN 5,526,484—filing date 12/10/1992), hereinafter Casper.**
21. **Regarding dependent claim 3, Puckett fails to disclose a process wherein step c) comprises parsing the received inbound document field-by-field and, for each field, checking the string byte size and delimiter characters. However, Dysart, in col. 16, lines 35-45 discloses field-by-field parsing in order to allow more exact control over search processing. It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate field-by-field parsing as in Dysart into Puckett in order to allow more exact control over search processing. In col. 16, lines 5-15 of Casper, Casper describes processing which involves string byte checking and delimiter characters in order to successfully frame commands. It would have been obvious to one of ordinary skill in the art at the time of the invention to use string byte checking and delimiter characters in the manner of Casper in the context of Puckett and Dysart in order to successfully frame commands.**
22. **Claims 4-5 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Puckett, further in view of Dysart et al. (USPN 6,708,166 B1—filing date 5/11/2000),**

**hereinafter Dysart, further in view of Casper, further in view of Dowling (USPN 6,157,988—filing date 12/23/1997).**

23. **Regarding dependent claim 4**, Puckett, Dysart, and Casper fail to disclose a process wherein step c) further comprises checking sequence of fields against allowable record field groupings including required, optional, or conditional fields. However, Dowling, in col. 16, lines 43-67 describes the classification and checking of field types including required, optional, and conditional in order to help organize fields. It would have been obvious to one of ordinary skill in the art at the time of the invention to employ the classification and checking of field types in the manner of Dowling in the context of Puckett, Dysart, and Casper including required, optional, and conditional in order to help organize fields.
24. **Regarding dependent claim 5**, Puckett fails to disclose a process in which the translator generates error data in step c) for field character set, character size, and delimiters and continues translation processing. However, Casper, in col. 11, lines 1-25, discloses error data that a processing unit generates error information when analyzing a frame which encompasses a character set, character size, and delimiters in order to prevent erroneous processing of frame contents. It would have been obvious to one of ordinary skill in the art at the time of the invention to generate error information in the manner of Casper in the context of Puckett in order to prevent erroneous processing of frame contents.
25. **Regarding dependent claim 10**, the claim is essentially equivalent to claim 5 in that field attribute, truncation, and character set errors are generated in claim 5, and rejecting

claim 10 is merely a manner of identifying them after construction of the document, which would have been obvious because they would have already been generated.

**26. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Puckett, further in view of Rusterholz et al. (USPN 4,945,479—filing date 7/31/1985), hereinafter Rusterholz.**

**27. Regarding dependent claim 8,** Puckett fails to disclose that the translation process is aborted if a target document field is not populated. However, in col. 66, lines 5-35, Rusterholz describes a translation process in which a requirement of the process to avoid abortion of the process is that the translation needs to be populated because it is on the same register (see line 12). The reason for this is that it allows verification of valid entries. It would have been obvious to one of ordinary skill in the art at the time of the invention to abort if a target document field is not populated in the manner of Rusterholz in the context of Puckett in order to allow verification of valid entries.

**28. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Puckett, further in view of Loebig (USPN 5,406,563—filing date 8/6/1993).**

**29. Regarding dependent claim 9,** Puckett fails to disclose a process wherein step c) comprises identifying errors after construction of a target document and output of said document through a stream. However, Loebig, in the Abstract, lines 1-10, discloses stream processing of documents in order to monitor errors in document processing. It would have been obvious to one of ordinary skill in the art at the time of the invention to process documents through a stream in the context of Puckett in the manner of Loebig in order to monitor errors in document processing.

30. **Claims 13 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Puckett.**

31. **Regarding dependent claim 13,** Puckett discloses the use of a variable that upon assignment of a subsequent value said subsequent value is treated as a valid variable value. (In Fig. 3, item 308, the information is translated into a tuple.) However, Puckett fails to disclose the use of a temporary variable that can only reference a single value. However, it was notoriously well known in the art at the time of the invention that variables that reference only one value are useful because they can be used to represent single pieces of information of particular import. It would have been obvious to one of ordinary skill in the art at the time of the invention to include in Puckett a temporary variable that can only reference a single value because it can be used to represent a single piece of information of particular import.

32. **Regarding independent claim 18,** it consists of independent claim 1, with dependent claims 12-14, 15, and 17 incorporated into the claim. Since these claims have already been rejected, claim 18 is rejected under similar rationale.

*Conclusion*

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

USPN 5,367,664 (filing date 8/30/1991)—Magill et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan D. Schlaifer whose telephone number is 703-305-9777. The examiner can normally be reached on 8:30-5:00, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on 703-308-5186. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JS



**STEPHEN S. HONG**  
**PRIMARY EXAMINER**